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EXAMINER

BAHTA, KIDEST

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANTHONY J. GRIGGS, CHARLES BURBANK,  
WILLIAM WILCOX, and KENNETH WOODBINE

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Appeal 2009-009127  
Application 10/687,861  
Technology Center 2100

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*Before* ALLEN R. MacDONALD, ROBERT E. NAPPI, and DEBRA K.  
STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 1-93. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

*Introduction*

According to Appellants, the invention is a system and method for generating a machine tool program for performing coordinate measurements (Abstract).

STATEMENT OF THE CASE

*Exemplary Claim(s)*

Claim 1 is an exemplary claim and is reproduced below:

1. A method comprising an act of:
  - (A) generating, from a dimensional metrology program, a machine tool program including instructions to control a machine tool to perform coordinate measurements, wherein the machine tool program is executable on a machine tool controller.

*Prior Art*

Matsumiya	US 6,671,571 B1	Dec. 30, 2003
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*Rejections*

Claims 1-93 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Matsumiya.

ISSUE

*35 U.S.C. § 102(e): claims 1-93*

Appellants argue their invention is not anticipated by Matsumiya because Matsumiya discloses a measuring machine performing coordinate measurements not a machine tool performing coordinate measurements (App. Br. 9-18; Reply 3-14). Appellants assert in their invention the coordinate measurements are performed on the same machine that performs the machining (the machine tool) in contrast to Matsumiya which has two different machines (the machine tool and measuring machine) (Reply Br. 3).

The Examiner finds Matsumiya discloses generating a machine tool program including instructions to control a machine tool to perform coordinate measurements (Fig. 1, element 31), wherein the machine tool program is executable on a machine tool controller (Fig. 1, element 27) (Ans. 4).

The issue is thus: Has the Examiner erred in finding Matsumiya discloses “a machine tool program including instructions to control a machine tool to perform coordinate measurements” as recited in claim 1?

It is unclear to us how the measuring machine which performs coordinate measurements (Fig. 1, element 31) is controlled by the machine tool program executable on a machine tool controller which the Examiner indicates is represented by Fig. 1, element 27 (NC program execution means). In response to Appellants’ arguments, the Examiner points to column 8, lines 12-44 that describe a measurement program that receives necessary information including information particular to setting of initial coordinate systems to create the necessary measurement program (Ans. 6).

We agree with the Examiner that Matsumiya discloses a program to control a tool to perform coordinate measurements. However, the Examiner does not explain and we cannot readily ascertain where Matsumiya discloses the measurement program is executable on the machine tool controller (Fig. 1, element 27).

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

*Net MoneyIN, Inc. v. VeriSign*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

Here, it is not clear based on the Examiner's mapping and findings, if the claimed limitations are arranged in the same way as recited in claim 1. "Where there is such doubt, the scales should be inclined toward the applicant." *In re Coley*, 40 F.2d 982, 986 (Cust. & Pat. App. 1930) (citations omitted).

Accordingly, we find the Examiner has not shown Matsumiya discloses the invention as recited in independent claim 1 and commensurately recited in independent claims 28, 31, 55, 57, 76, 77, 78, 79, 84, 86, 92, and 93. Dependent claims 2-27, 29, 30, 32-54, 56, 58-75, 80-83, 85, and 87-91 stand with their respective independent claims. Therefore, the Examiner erred in rejecting claims 1-93 under 35 U.S.C. § 102(e) for anticipation by Matsumiya.

Appeal 2009-009127  
Application 10/687,861

DECISION

The Examiner's rejection of claims 1-93 under 35 U.S.C. § 102(e) as being anticipated by Matsumiya is reversed.

REVERSED

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